

DEC 06 2004



Applicant

TERMINAL DISCLAIMER UNDER 37 C.F.R. § 1.321

Appl. No. : 10/770739

Filed : February 3, 2004

For : PRE-FINISHED AND DURABLE
BUILDING MATERIAL

Examiner : Camie S. Thompson

Group Art Unit : 1774

CERTIFICATE OF MAILING

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on

December 1, 2004

(Date)

Sewing H. Lee, Rec. No. 43,745

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In accordance with 37 C.F.R. § 3.73(b), Assignee of Record, JAMES HARDIE RESEARCH PTY LIMITED, an Australian corporation, represents that it is the assignee of record of the entire right, title and interest in the above-captioned patent application by virtue of an assignment from the inventors Weiling Peng, James A. Gleeson, and Donald J. Merkley, of the patent application identified above. Assignee of Record has executed and is in the process of recording an assignment of its entire right, title, and interest in and to the above-captioned patent application to JAMES HARDIE INTERNATIONAL FINANCE B.V., a Netherlands corporation, having its principal place of business at Unit 04-07, Atrium Building, Strawinskylaan 3077, 1077 ZX Amsterdam, The Netherlands ("JHIF").

This application is a continuation of copending application Serial No. 09/716,681, filed November 20, 2000, now U.S. Patent 6,689,451.

Assignee of Record also represents that it is the assignee of record of the entire right, title and interest in and to U.S. Patent No. 6,689,451 by virtue of assignment from the inventors, Weiling Peng, James A. Gleeson, and Donald J. Merkley. Assignee of Record has also executed and is in the process of recording an assignment of its entire right, title, and interest in and to U.S. Patent No. 6,689,451 to JHIF. The assignment of both the above-captioned application and U.S. Patent No. 6,689,451 to Assignee of Record was conveyed in a single assignment document which was filed with the U.S. Patent and Trademark Office, recorded at Reel 11982, Frame 978.

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The terminal portion of any patent granted on the above-captioned application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §§ 154-156 and 173, as presently shortened by any terminal disclaimer, of U.S. Patent No. 6,689,451, is hereby disclaimed by this Terminal Disclaimer. Any patent so granted on the above-captioned application shall be enforceable only for and during such period that legal title to said patent shall be the same as legal title to U.S. Patent No. 6,689,451. This agreement extends to any patent granted on the above-captioned application, and binds Assignee of Record, JHIF, and any successors and assigns.

This Terminal Disclaimer does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154-156 and 173 of U.S. Patent No. 6,689,451, as presently shortened by any terminal disclaimer, in the event that U.S. Patent No. 6,689,451, later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321, has all its claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

The undersigned representative verifies that he is authorized to take this action on behalf of Assignee of Record and JHIF.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 12-1-04

By: 

Sabing H. Lee
Registration No. 43,745
Attorney of Record
Customer No. 20,995
(949) 760-0404



In re application of : Weiling Peng, et al.
App. No. : 10/770,739
Filed : February 3, 2004
For : PRE-FINISHED AND DURABLE
BUILDING MATERIAL
Examiner : Camie S. Thompson
Art Unit : 1774

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December 1, 2004

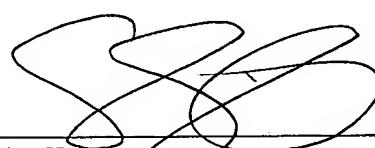

(Date)
Sabing H. Lee, Reg. No. 43,745

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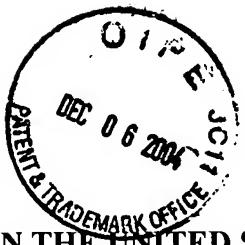
Sir:

Transmitted herewith is a response to Office Action in the above-identified application.

- Terminal Disclaimer Under 37 C.F.R. § 1.321.
- Return prepaid postcard.
- A check in the amount of \$110 is enclosed.
- Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.
- Please use Customer No. 20,995 for the correspondence address.



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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(Date)

Sabing H. Lee, Reg. No. 43,745

REMARKS TO OFFICE ACTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is in response to the Office Action mailed September 1, 2004 regarding the above-identified patent application. Claims 1-16 are pending in the present application. In view of the following remarks, Applicant submits that this application is in condition for immediate allowance.

Double Patenting Rejection

Examiner rejected Claims 1-16 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-50 of U.S. Patent No. 6,689,451. Examiner submits, however, that filing a terminal disclaimer may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the allegedly conflicting patent is shown to be commonly owned with this application. Because U.S. Patent No. 6,689,451 and the present application are commonly owned, Applicant submits a terminal disclaimer pursuant to 37 CFR 1.321(c). Accordingly, Applicant respectfully requests Examiner to withdraw this rejection.

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CONCLUSION

In view of the foregoing remarks and the terminal disclaimer enclosed herewith, Applicant submits that this application is in condition for allowance and such action is respectfully requested. If any issues remain or require further clarification, Examiner is respectfully requested to call Applicant's counsel at the number indicated below in order to resolve such issues promptly.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP



Dated: 12-1-07

By: _____

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AMEND

AWC-2973; 102904